

REMARKS

Claims 1-3, 5-15, 17-24 and 27-48 are pending as of the office action mailed on October 18, 2007.

Claims 1, 10, 12, 13, 22, 24, 27, 32, 40, 44, 46, and 48 are being amended. No claims are being cancelled or newly added. No new matter has been added. Support for the amendments can be found in the specification, for example, on page 5, line 3 through page 7, line 6.

Reexamination of the application and reconsideration of the action are respectfully requested in light of the foregoing amendments and the following remarks.

Claim Objections

Claims 1, 13, 27 and 32 were objected to for allegedly needing clarification. To expedite prosecution, and in accordance with the examiner's suggestions, claims 1, 13, 27, and 32 have been amended.

Withdrawal of the objections to claims 1, 13, 27, and 32 is therefore respectfully respected.

Section 102 Rejections

Claims 27-31 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Pub. No. 2004/0260717 ("Albornoz").

On page 25 of the Office Action mailed October 18, 2007, the examiner asserts that "the invention *embeds* the code that is necessary to render the content, layout and executables of the annotation "instance" *into a PDF document*." The applicant respectfully submits that other embodiments are possible, but to expedite prosecution, and without conceding that the invention only *embeds* the code that is necessary to render the content, layout and executables of the annotation "instance" *into a PDF document*, the applicant has amended claim 27.

Claim 27, as amended, requires creating one or more annotation instances using the variable layout information included in a dynamic annotation template, where the one or more annotation instances are stored within the electronic document.

In rejecting claim 27, the examiner relies upon Alborno. The applicant respectfully submits that Alborno does not teach or suggest storing the annotation instances within the electronic document. In fact, in Alborno, "the annotations 132 may be stored in a central annotation repository (e.g., annotation store 130)", (Alborno, paragraph #0039). The applicant respectfully submits that storing annotation (instances) in a central annotation repository is not storing annotation instances within the electronic document. Thus, Alborno does not teach or suggest every claim limitation of amended claim 27.

The applicant respectfully submits that claim 27 is in condition for allowance.

Claims 28-31 depend from independent claim 27 and are allowable for at least those reasons that apply to claim 27.

Withdrawal of the rejection under 35 U.S.C. § 102(e) is therefore respectfully requested.

Section 103 Rejections

Claims 1-3, 6-8, 10-15, 18-20, 22-24, 32-34, 36-38 and 40-42 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MapSoft Impress Pro Ver. 2.1 ("MapSoft") in view of Alborno, in further view of U.S. Patent No. 6,546,405 ("Gupta").

Claims 5, 9, 17, 21, 35, 39, 43, 45 and 47 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MapSoft in view of Alborno and Gupta, and in further view of U.S. Patent No. 6,721,921 ("Altman").

Claims 44, 46 and 48 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over MapSoft in view of Alborno and Gupta, and in further view of U.S. Patent Pub. No. 2004/0034832 ("Taylor").

Claims 1, 13 and 32

To expedite prosecution, claims 1, 13, and 32 have been amended. Specifically, claims 1, 13, and 32 have been amended to clarify receiving a request to display an annotation in an electronic document, where an instance of an annotation is created using variable layout information included in an annotation template, and the annotation instance is stored within the electronic document.

The applicant respectfully submits that the combined teachings of MapSoft, Albornoz, Gupta, Altman, and Taylor do not teach or suggest receiving a request to display an annotation in an electronic document, where an instance of an annotation is created using variable layout information included in an annotation template, and the annotation instance is stored within the electronic document, as required by amended claim 1, 13, and 32.

The applicant respectfully submits that claims 1, 13, and 32 are in condition for allowance.

Remaining Claims

The remaining claims depend from or correspond to independent claims 1, 13 and 32 and are allowable for at least the reasons that apply to those independent claims.

Withdrawal of the rejection under 35 U.S.C. § 103(a) is therefore respectfully requested.

Conclusion

For the foregoing reasons, the applicant submits that all the claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the applicant's decision to amend or cancel any claim should not be understood as implying that the applicant agrees with any positions taken by the examiner with respect to that claim or other claims.

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Page : 14 of 14

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Respectfully submitted,

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